

Appl. No. 09/711,866

Amdt. Dated January 6, 2004

Reply to Office Action of October 6, 2003

REMARKS

Reconsideration of the application is requested.

Applicant acknowledges the Examiner's confirmation of receipt of applicant's certified copy of the priority document for the German Patent Application 199 54 346.1, filed November 11, 1999 supporting the claim for priority under 35 U.S.C. § 119.

Claims 1-27 are in the application. Claims 1-27 have been rejected. Claim 10 has been amended.

In item 1 on page 2 of the above-identified Office Action, the Examiner requested the drawings be designated by a legend, such as -- PRIOR ART--under MPEP § 608.02(g). The Examiner's suggested corrections are respectfully traversed, as Fig. 5 "is a schematic diagram showing the basic structure of a memory device of the type presently considered." As the present invention is being "presently considered" Fig. 5 does not only represent prior art. The mere fact that an item includes some components that are "old" as designated by MPEP § 608.02(g) does not necessitate that the entire figure is prior art.

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In item 2 on page 2 of the above-identified Office Action, the Examiner objected to the drawings under 37 CFR § 1.83(a) because they fail to show where the input signals "TESTCONTROL" and "NORM CONTROL" come from. The Examiner is respectfully invited to review the disclosure for the referenced input signals, which are extensively discussed in the specification on pages 20, 21, and 23. It is clear from the specification that these input signals may be used in a variety of ways, but that the source or "where the input signals . . . come from" are not essential for a proper understanding of the disclosed invention. Rather the specification indicates that "Both the signal TESTCONTROL and the signal NORMCONTROL can optionally assume the level 0 or 1." Moreover, the specification also indicates that "The line carrying the signal NORMCONTROL is connected via a fuse F to a potential," which varies according to the operating conditions of the memory device. Accordingly, this objection is respectfully traversed.

In item 3 on page 2 of the above-identified Office Action, the Examiner objected to the drawings as failing to comply with 37 CFR § 1.83(o), because the outputs of the elements AND1 do not include suitable descriptive legends. 37 CFR § 1.83(o) states that "Suitable descriptive legends **may** be used . . . or **may** be required by the examiner **where**

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necessary for understanding of the drawing." In the present invention, descriptive legends are not necessary for understanding the drawing. Specifically, the AND gates AND1, each only have **one output signal**, which is suitably designated by a directional arrow in Fig. 1, so there is no possibility for confusion. Moreover, a similar, although not identical, drawing exists in Fig. 1 of U.S. Patent No. 6,314,031 to Sellmair, et al. and did not require legends on the output signal from the similar element **for understanding of the drawing**. Accordingly, this objection is respectfully traversed.

In item 4 on page 2 of the above-identified Office Action, the Examiner objected to the drawings as failing to comply with 37 CFR § 1.83(p)(1), because "reference characters have to be appeared in the drawings Figs. 1-5." Figs. 1-5 of the instant application already have reference characters that are used in the specification to indicate an element in the figures. For example, reference characters VE1, VE2, VE3, and VE4 refer to comparison units in Fig. 1.

Moreover, a portion of Fig. 1 of U.S. Patent No. 6,314,031 to Sellmair, et al. includes Fig. 1 of the instant application and did not require additional reference characters. Furthermore, Fig. 5 in the instant application

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is identical to Fig. 2 of U.S. Patent No. 6,314,031 to Sellmair, et al. and did not require additional reference characters. The remaining figures, Figs. 2-3, of the instant application already have reference characters for each part of the figure. Accordingly, this objection is respectfully traversed.

In item 5 on page 2 of the above-identified Office Action, the Examiner objected to the drawings as failing to comply with 37 CFR § 1.84(p)(4), because "the same reference character must never be used to designate different parts" as allegedly done by blocks K3 and K4 in Fig. 1. The applicant respectfully traverses this objection as "K3" and "K4" are clearly different reference characters. In the present case, the reference characters have been selected to assist the Examiner in quickly understanding the invention and the various relationship between the components. For example, the same letter "K" is used to indicate a similarity between the elements, but the different number indicates that the elements are different. As such the combinations create different reference characters. For example, transistors would be properly labeled as T1 and T2.

Should the Examiner determine to maintain any of the previously discussed objections, which have been traversed

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in this response, the applicant respectfully requests that the Examiner provide a more detailed description of the exemplary changes he would like the applicant to make in the application.

In item 6 on page 3 of the above-identified Office Action, the Examiner objects to the disclosure because of "missing parts" in the description on page 21, lines 17 and 22. As lines 17 and 22 are blank lines used to separate the last three paragraphs on page 21. Applicant is unclear as to corrective measures that the Examiner desires. More specifically, the specification on page 21 appears to be in the proper form and accurately describes various properties of the "potential" that is connected via fuse F to the line carrying the signal NORMCONTROL. As such, the objection is respectfully traversed. However, the applicant has amended, solely for clarification or cosmetic reasons, the last three paragraphs on page 21 to include different punctuation, such as inserting a colon and a semicolon and removing two dashes.

In item 7 on page 3 of the above-identified Office Action, the Examiner objects to the abstract because it is not descriptive. As indicated on page 4 of the Office Action, the abstract should include "if a machine or apparatus, its

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organization and operation . . . if a process, the steps"

Accordingly, the "Abstract of the Disclosure" in the present case discloses a memory device containing "comparison units" with which it is possible to check if an address received by the memory device is associated with or located in a memory cell. Moreover, the comparison units have a different operation state during a memory device test. As such, the abstract does provide the "organization and operation" of the present invention and the objection is respectfully traversed.

In item 8 on page 4 of the above-identified Office Action, claims 1-27 have been rejected as failing to comply with the enablement requirement under 35 U.S.C. § 112, first paragraph. More specifically, the Examiner states that the disclosure does not provide any description regarding signals "TEST", "TESTCONTROL", "NORMCONTROL", input of "F", "FALTADR", and "TESTADR" in the memory device, which the applicant claims as the invention.

Initially, it is noted that the previously mentioned signals ("TEST", "TESTCONTROL", "NORMCONTROL", input of "F", "FALTADR", and "TESTADR") are not claimed as such in the two independent claims 1 and 16 and as a result the claims cannot be rejected with regard to the signals under 35

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U.S.C. § 112, first paragraph. Moreover, the dependent claims do not require the use of the previously identified signals to enable any person skilled in the art to make and use the invention. Lastly, it is the applicants' position that there is more than adequate support in the specification to enable any person skilled in memory devices to make and use the present invention. Furthermore, the previously identified signals have all been described in a manner adequate to enable any person skilled in the art to make and use the invention.

The control signal TEST is described in detail on pages 19-21 and 23 of the specification of the instant application. As discussed, the control signal TEST is supplied to the comparison units to activate or deactivate a test mode within the memory device. As the invention is limited to the memory device, it is unnecessary to provide further disclosure concerning the origins of an outside control signal. However, to one skilled in the art of memory devices it is clear that a test device would most likely provide/generate such test signals.

The input signals TESTCONTROL and NORMCONTROL are discussed on pages 20, 21, and 23. These input signals are also provided by devices known to one of skill in the art that

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are external to the memory device being claimed in the instant application. As discussed in the specification, the TESTCONTROL and NORMCONTROL signals help determine which comparison units are activated during the normal and the test operational modes of the memory device. Moreover, the input terminal of the fuse F, primarily discussed on pages 21-24 of the specification, may be permanently connected with a potential representing a high or low level. The use of a fuse would be understood by one of skill in the art.

The addresses indicated by FAULTADR and TESTADR are signals described on page 27 of the specification. As is known to one of skill in the art, a test device often controls the test environment. Specifically, the test device might generate a specific set of bits in a specific order so that every control path and data path in the device being tested is toggled at least once during a given test. As indicated in the specification, FAULTADR and TESTADR are input address signals that help predetermine the test results. But the process of selecting these test signals is outside the scope of the instant application and is not necessary for an understanding of the present invention.

Clearly, there is sufficient disclosure in the written description of the invention of the instant application to

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enable any person skilled in the art to make and use the present invention.

In item 9 on page 5 of the above-identified Office Action, claims 6, 7, 10, 15, and 16 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner states that claim 6 recites the limitation "... wherein the addresses of memory cells which cannot be properly written to or read out..." and fails to provide sufficient antecedent basis in claim 2.

Applicant respectfully submits that proper antecedent basis for "the addresses of memory cells" in claim 6 may be found in claim 1, the base claim. Claim 1 states that "an address applied to the memory device is associated with a memory cell which cannot be properly written to or read out" and that that there are a multiplicity of memory cells.

The Examiner states that claim 7 recites the limitation "... wherein the test addresses ..." and therefore lacks antecedent basis in claim 2. Applicant respectfully disagrees with the language quoted by the Examiner and as a result with the rejection of claim 7. According to the applicants file, claim 7 on page 30 states:

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7. The memory device according to claim 2, **wherein test addresses** suitable for testing the memory device are defined as reference addresses. (emphasis added)

Since the element "test addresses" is plural it is not necessary to use "a" or "an" in front of the limitation. Moreover, since the claim does not use "the" it may be implied that this is the first instance of "test addresses" and so claim 7 is properly presented.

The Applicant has amended claim 10 as requested by the Examiner.

The Examiner states that claim 15 recites the limitation "... wherein such a number ..." that has insufficient antecedent basis in claim 12. Applicant respectfully disagrees and traverses the rejection of claim 15, as the language "a number" indicates a first instance and does not require antecedent basis.

The Examiner states that claim 16 is incomplete under MPEP § 2172.01 for omitting essential structural cooperative relationships through the use of "according to claim 1" in an independent method claim. Applicant respectfully requests that the Examiner review MPEP § 2173.05(f) that states:

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A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph. For example, claims which read: "The product produced by the method of claim 1." or "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions....." are not indefinite under 35 U.S.C. 112, second paragraph, merely because of the reference to another claim. See also *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) where reference to "the nozzle of claim 7" in a method claim was held to comply with 35 U.S.C. 112, second paragraph. However, where the format of making reference to limitations recited in another claim results in confusion, then a rejection would be proper under 35 U.S.C. 112, second paragraph.

In the instant case, claim 16 properly references claim 1, without attempting to make reference to limitations in claim 1. Claim 16 states, *inter alia*, a method of operating a memory device that includes "providing a memory device ... according to claim 1" which is in accordance with MPEP § 2173.05(f) and *Ex parte Porter*. Accordingly, this rejection is respectfully traversed.

It is accordingly believed that the specification and the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. The above-noted changes to the claims are provided solely for clarification or cosmetic reasons. The changes are neither provided for overcoming the prior

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art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In item 10 on page 6 of the above-identified Office Action, claims 1-27 have been rejected as being fully anticipated by U.S. Patent No. 6,314,031 to Sellmair, et al. (hereinafter '031) under 35 U.S.C. § 102(e).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references. More specifically, the cited art, '031, is not prior art to the present invention and as such is not available as prior art pursuant to Section 102(e).

'031 and the present invention were both filed in the U.S. on the same day, November 13, 2000. As indicated in item 10, 35 U.S.C. § 102(e) requires that "the invention was described in (1) an application for patent . . . by another filed in the United States **before** the invention by the applicant for patent or . . . a patent . . . by another filed in the United States **before** the invention by the applicant for patent." In the instant case, '031 was not filed **before** the present invention, but rather at the same time.

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Moreover, the instant application claims the benefit of priority under 35 U.S.C. § 119 from German Patent Application 199 54 346.1 filed November 11, 1999, which is also the foreign priority date of '031. However, the foreign priority date of '031 is not available to be used against the instant application. Clearly, '031 is not prior art to the present application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1 and claim 16. Claim 1 and claim 16 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1 or claim 16.

In view of the foregoing, reconsideration and allowance of claims 1-27 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

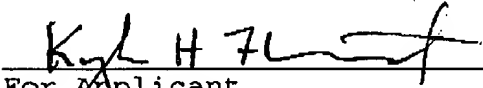
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Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,


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KHF:cgm

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